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PTO/SB/30 (09-04)

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# Request for Continued Examination (RCE) Transmittal

Address to:  
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P.O. Box 1450  
Alexandria, VA 22313-1450

Application Number	09/209,706
Filing Date	12/11/98
First Named Inventor	Edward Tokas et al
Art Unit	1733
Examiner Name	Geoffrey Knable
Attorney Docket Number	IR-2588 (ET)

**This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.**  
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

a. ☒ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_

ii. ☐ Other \_\_\_\_\_

b. ☒ Enclosed

i. ☒ Amendment/Reply

iii. ☐ Information Disclosure Statement (IDS)

ii. ☐ Affidavit(s)/ Declaration(s)

iv. ☐ Other \_\_\_\_\_

2. **Miscellaneous**

a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

b. ☐ Other \_\_\_\_\_

3. **Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.  
The Director is hereby authorized to charge the following fees, or credit any overpayments, to

a. ☒ Deposit Account No. 12-2143 I have enclosed a duplicate copy of this sheet.

i. ☒ RCE fee required under 37 CFR 1.17(e)

ii. ☒ Extension of time fee (37 CFR 1.136 and 1.17)

iii. ☐ Other \_\_\_\_\_

b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed

c. ☐ Payment by credit card (Form PTO-2038 enclosed)

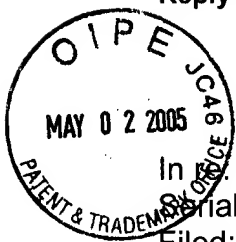
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED			
Signature	<i>Miles B. Dearth</i>	Date	April 28, 2005
Name (Print/Type)	Miles B. Dearth	Registration No.	35,115

CERTIFICATE OF MAILING OR TRANSMISSION			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.			
Signature	<i>Miles B. Dearth</i>	Date	April 28, 2005
Name (Print/Type)	Miles B. Dearth	Date	April 28, 2005

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Tokas, et al. Docket No.: IR-2588(ET)  
Serial No.: 09/209,706 Art Unit: 1733  
Filed: December 11, 1998 Examiner: Geoffrey L. Knable  
For: "Contact Metathesis Polymerization"

**Amendment Accompanying an RCE**

April 28, 2005

Assistant Commissioner of Patents  
Box Fee Amendment  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated Nov. 30, 2004, Applicants file herewith a request for continued examination and submit the following amendments placing the claims in condition for allowance.

Claim 159 is canceled below as redundant to claim 56. The dependency of claim 64 is changed to depend from claim 56.

Amendments adding the word "said" were made to claims 64, 154 and 165.

Claims 54, 56, 57, 59-62, 64-83, 93, 94, 96, 98-102, 104-107, 110-114, 117-142, 144, 145, 148, 154, 155, 158-160, 165, 166 and 169-171 were rejected under 36 U.S.C. 112, second paragraph as claims 56, 57, 64 159, and 170 raised a question of whether a metal surface is being coated. Applicants agree with the Office interpretation that the coating must be on the metal substrate. The focus for the indefiniteness issue is whether it is indefinite to allow the invention to be particularly pointed out in some situations where a portion of the substrate is covered by an elastomer, as in claim 56.

Claims 56 is amended to clarify that the metal substrate is a manufactured article containing a substantially cured elastomeric material on a portion of said metal substrate.

Support for the amendment is on page 22 in the following passage:

"The types of substrate surfaces that can be coated or bonded according to the invention vary widely. The substrates, of course, are articles of manufacture that are themselves useful. Such substrates could include machined parts made from metal and elastomers."

Applicants point out that the coating is applied to a metal substrate and this is not indefinite where an elastomer is part of the metal article and occupies a portion of the surface. Such rubber-bonded metal articles are ubiquitous and common in the industry, for example an engine mount is a rubber-metal article. Portions of that article have metal exposed to air, and portions underneath the elastomer, and not exposed to air. Applicants' assignee is in the business of engineering hundreds of millions of dollars of such rubber-metal bonded articles. These are the various devices such as dampers, isolators, bushings, and rubber bearings. These are so common in the art as to be readily recognized.

Claim 56 can be clearly interpreted in light of the definition of "surface" on page 6 in the following passage:

"surface" means a region of a substrate represented by the outermost portion of the substrate defined by material/**air interface** and extending into the substrate from about 1 atomic layer to many thousands of atomic layers." (bold added)

If the outermost portion of the metal substrate were covered by an elastomer, it is clear that this surface is not exposed to the air. Skilled persons understand in forming a coating on the metal substrate of an article that has a portion of its surface bonded to an elastomer, that no coating would be formed "on the metal substrate surface" in the portion covered by the elastomer.

The following passage also supports the definite concept of coating only a portion of the metal substrate, at page 20:

"According to a preferred embodiment of the invention the liquid catalyst (either by itself or as a component of a multi-component catalyst composition) is applied to the

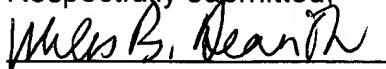
substrate surface. The catalyst can be applied to achieve continuous surface coverage or **coverage only in predetermined selected areas** by any conventional coating/printing means such as spraying, dipping, brushing, wiping, roll-coating or the like. The metathesizable material can be contacted with the resulting catalyzed-coated surface when it is still wet.” (bold for emphasis)

The above passage is understood by the skilled person as applying catalyst and metathesizable material only to a portion of the surface, and in the case of claim 56, the reason why is clear and not indefinite- the elastomer occupies a portion of the substrate surface. Applicants submit that it is definite and clear that if an elastomer is present on a portion of the metal substrate, that the metal surface under the bond would not be exposed for applying the invention, and that the practitioner would apply the method of coating to the unbonded (exposed) metal surface.

Claim 56 is to be read with claim 99, so that definite features of claim 99 apply, as in the method being the forming of a coating on a metal substrate surface. It is clear from the record that the public will understand that the method is limited to forming a coating on a metal substrate and that it is within the scope of the invention to use a metal substrate that has an elastomer attached to a portion. It is clear, in light of the specification and ordinary skill with common industrial rubber-metal articles that where no metal substrate surface is exposed to the air that no coating will be formed there.

The Office is authorized to charge deposit account 12-2143 the amount required for the petition for extension of time for filing a response to the Office Action. Reconsideration and withdrawal of the claim rejections and allowance of the amended claims are respectfully requested.

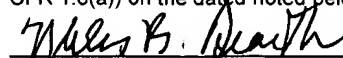
Respectfully submitted,



Miles B. Dearth, Attorney for Applicants

CERTIFICATE OF MAILING per 37 CFR 1.8(a)

The person signing below hereby certifies that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date indicated below with the United States Postal Service in an envelope addressed to the Assistant Commissioner of Patents, Alexandria, VA 22313-1450, with sufficient postage as first class mail (37 CFR 1.8(a)) on the date noted below.

 Date: 4-28-05

Printed name: Miles B. Dearth